

**REMARKS**

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the remarks, which place the application in condition for allowance or in better condition for appeal.

Claims 10 to 23 are pending. It is submitted that these claims are patentably distinct from the documents cited by the Examiner, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The remarks made herein are not for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but rather the remarks are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

No new matter is added.

Any additional fees occasioned by this paper, or any overpayment therein, may be charged or credited to Deposit Account No. 50-0320.

Claims 10 to 14 and 17 to 23 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,532,030 to Hirose et al. ("Hirose"); claim 15 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hirose; and claim 16 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hirose, in view of U.S. Patent No. 5,556,920 to Tanaka et al. ("Tanaka"). These rejections will be addressed collectively and are respectfully traversed. It is submitted that these rejections are unwarranted and reconsideration and withdrawal are respectfully requested.

The present invention is directed to, *inter alia*, a mono- or multilayer film comprising at least one layer of a cycloolefin copolymer, and where, at approximately 85% relative humidity and at a temperature of approximately 23<sup>0</sup>C, the mono- or multilayer film has a water vapor

permeation of  $\leq 0.035 \text{ g}^* \text{ mm/m}^2 \text{ d}$ , a puncture resistance of  $\leq 300 \text{ N/mm}$  and a thickness of  $\leq 100 \mu\text{m}$ . Hirose fails to disclose, teach or suggest the present invention.

It is respectfully pointed out that a two-prong inquiry must be satisfied in order for a Section 102 rejection to stand. First, the prior art reference must contain all of the elements of the claimed invention. *See Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Second, the prior art must contain an enabling disclosure. *See Chester v. Miller*, 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1990). A reference contains an enabling disclosure if a person of ordinary skill in the art could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself in possession of the invention. *See In re Donohue*, 226, U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Applying the law to the instant facts, Hirose does not disclose, suggest or enable Applicants' invention. Firstly, Hirose does not contain all of the elements of the instant claims, e.g., a water vapor permeation of  $\leq 0.035 \text{ g}^* \text{ mm/m}^2 \text{ d}$ , a puncture resistance of  $\leq 300 \text{ N/mm}$  and a thickness of  $\leq 100 \mu\text{m}$ , at approximately 85% relative humidity and a temperature of approximately  $23^\circ \text{C}$ . Accordingly, the Final Office Action failed to meet its burden in showing that Hirose contains every limitation of the rejected claims.

The Final Office Action contends that these properties are inherent in the multilayer laminate allegedly disclosed in Hirose (Final Office Action, at 3). Applicants disagree as none of these properties are inherent in Hirose. It is respectfully asserted that it is not enough for the Final Office Action to simply contend that the compounds or methods in the relied-upon document "inherently" speak to the instantly claimed invention. The case law is clear that the document must disclose or suggest the properties for inherency to attach. According to *In re Rijckaert*, 9 F.3d 1531, 1957 (Fed. Cir. 1993), "such a retrospective view of inherency is not a substitute for some teaching or suggestion[.]" The Federal Circuit teaches that

“inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency].” *Continental Can Company v. Monsanto Company*, 948 F.2d 1264, 1269 (Fed. Cir. 1991), citing to *In re Oelrich*, 666 F.2d 578, 581-582 (C.C.P.A. 1981). Indeed, “before a reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is *necessarily* present in the reference.” *SGS-Thomson Microelectronics, Inc. v. International Rectifier Corporation*, 31 F.3d 1177 (Fed. Cir. 1994) (emphasis in original).

Applying the law to the instant facts, the document cited in the Final Office Action does not inherently teach, disclose or suggest Applicants’ invention. That is, Hirose does not inherently teach, disclose or suggest, *inter alia*, a water vapor permeation of  $\leq 0.035 \text{ g}^* \text{ mm/m}^2 \text{ d}$ , a puncture resistance of  $\leq 300 \text{ N/mm}$  and a thickness of  $\leq 100 \mu\text{m}$ , at approximately 85% relative humidity and a temperature of approximately  $23^0\text{C}$ . Even assuming, *arguendo*, that these properties could have existed in the Hirose laminate, absent a teaching of these properties in Hirose, inherency simply cannot attach. *Continental Can*, 948 F.2d at 1269. Consequently, inherency is not a viable basis for unpatentability.

Secondly, Hirose does not enable the instant invention, e.g., a mono- or multilayer film comprising at least one layer of a cycloolefin copolymer, and where, at approximately 85% relative humidity and at a temperature of approximately  $23^0\text{C}$ , the mono- or multilayer film has a water vapor permeation of  $\leq 0.035 \text{ g}^* \text{ mm/m}^2 \text{ d}$ , a puncture resistance of  $\leq 300 \text{ N/mm}$  and a thickness of  $\leq 100 \mu\text{m}$ . Hirose relates to a polyolefin multilayer laminate in which at least one layer consists of a cycloolefin-based resin (*See Abstract of the Hirose patent*). Hirose does not enable, however, a mono- or multilayer film comprising at least one layer of a cycloolefin

copolymer, and where, at approximately 85% relative humidity and at a temperature of approximately 23°C, the mono- or multilayer film has a water vapor permeation of  $\leq 0.035$  g\*mm/m<sup>2</sup>d, a puncture resistance of  $\leq 300$ N/mm and a thickness of  $\leq 100\mu\text{m}$ .

The instant patent application, on the other hand, claims, *inter alia*, a mono- or multilayer film comprising a cycloolefin polymer and (emphasis added) possessing a specific set of properties (e.g., water permeation, puncture resistance and thickness). In particular, the puncture resistance of the films is obtained by selected processing of the film; such processing and such films with the above-noted properties are neither taught, disclosed nor enabled from Hirose. The Examiner's attention is respectfully invited to review page 11, lines 11 to 14 of the specification, which specifically explains the characteristics of the cyclic olefin copolymer (COC) base as:

[T]he COC base film and the backing film have similar action as water vapor barriers, the thickness of the backing film cannot be reduced at will in order to adjust its puncture resistance. This implies a thickness for COC-based backing films in the range from 20 to 150  $\mu\text{m}$ .

In addition, the Examiner is further invited to review the originally filed specification, page 8, line 8 to page 10, line 7 which provides a list of transition metal compounds in accordance with the present invention, and page 13, lines 15 to 29 which specifically teach how the film in accordance with the present invention can be simultaneously biaxially stretched. The Examiner is also respectfully directed to the properties of the film processed as prescribed in Example 2 and finally, to page 15, lines 18 to 35 under Examples 8 to 10 which list the specific properties in directions of stretching.

Conversely, Hirose only generally mentions that its films can be stretched mono- or biaxially (*See* col. 34, lines.42-45). Stretching of films is generally known in the art. Thus Hirose does not disclose, nor enables, any more than what one skilled in the art would expect to do after preparation of the films. In other words, Hirose fails as an anticipatory reference

because it does not enable the specific combination of properties and the specific manner of treatment of the instantly claimed films. Accordingly, the present invention could not possibly have been anticipated by, or been obvious in view of, Hirose.

The films according to the present invention are preferably used for blister packs, and especially preferred as a backing film for blister packs (*see* specification page 1, lines 7-10). For this application the film must be easy to puncture (*see* specification page 3, lines 3-5). In order to achieve the desired puncture resistance (as claimed and defined in claim 20) a specific orientation has to be given to the films (*see* specification page 11, lines 18-24). Moreover, the mechanical properties of the film have to be selected properly in order to ensure reliable processing (*See comp.* page 11, lines 24-26).

According to the disclosure in the present application, if the stretching conditions are not chosen properly, the claimed puncture resistance is not achieved. The Examiner is respectfully invited to once again review Examples 2 and 9 to 10. Any disclosure of the preceding is lacking in Hirose's disclosure, thus, Hirose fails to enable Applicants' invention. Accordingly, the present invention is clearly patentable over Hirose.

Consequently, reconsideration and withdrawal of the Section 102 rejections are believed to be in order and such action is respectfully requested.

Applicants likewise reassert that the rejection of claims 15 and 16 under 35 U.S.C. § 103(a), based on Hirose, either alone or in combination with Tanaka, is unwarranted. Despite the statements in the Final Office Action, it is urged that one skilled in the art, using Hirose and Tanaka, would not be led to Applicants' claimed invention.

Specifically, Hirose, either individually or in combination with Tanaka, fails to disclose, suggest, or motivate a skilled artisan to practice the presently claimed invention. The Examiner is respectfully reminded of the case law; namely, that there must be some prior art teaching

which would have provided the necessary incentive or motivation for modifying the reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Hirose does not disclose a mono- or multilayer film comprising a cycloolefin polymer and possessing a specific set of properties, such as water permeation, puncture resistance and thickness, as claimed and disclosed in the present invention. In particular, the puncture resistance in accordance with the present invention is obtained by a selected processing of the film, the disclosure of which is lacking in Hirose.

Tanaka does not remedy the deficiencies inherent in Hirose. Tanaka relates to a stretched polypropylene film having a crystalline polypropylene and a small amount of monocyclic olefin polymer. The film is said to have improved transparency and image clarity. Nowhere in Tanaka, however, is there any disclosure, suggestion, or teaching of the instantly claimed mono- or multilayer film comprising at least one layer of a cycloolefin copolymer, and where, at approximately 85% relative humidity and at a temperature of approximately 23<sup>0</sup>C, the mono- or multilayer film has a water vapor permeation of  $\leq 0.035 \text{ g}^* \text{ mm/m}^2\text{d}$ , a puncture resistance of  $\leq 300\text{N/mm}$  and a thickness of  $\leq 100\mu\text{m}$

Submitted herewith is the Declaration under 37 C.F.R. §1.132 of Dr. Wilfried Hatke, a co-inventor of the instant application. Dr. Hatke was awarded his degree from Philipps University Marburg, Germany, and is currently a chemist. Dr. Hatke has ten years of experience in the fields of polymer chemistry and polymer processing.

Dr. Hatke notes that the instantly claimed mono- or multilayer film properties are surprisingly based on how the films are processed. Dr. Hatke explains that stretching of a non-oriented film increases the modulus of elasticity, tear strength, elongation at break and puncture resistance. Dr. Hatke goes on to explain that the increase of the modulus of elasticity, tear strength and elongation at break depends on the degree of stretching. Further, films biaxially stretched have a significantly improved puncture resistance. Dr. Hatke concludes that Hirose does not teach, suggest or disclose that the degree of stretching in combination with the direction(s) of stretching have to be chosen to obtain a desired value of puncture resistance. Thus, a skilled artisan would readily understand that the instantly claimed invention is not rendered obvious by Hirose, as Hirose neither discloses, suggests or teaches that the instantly claimed properties of the mono- or multilayer film is obtained by a selected processing of the film.

Consequently, the Section 103 rejection cannot stand. The present invention is neither taught nor suggested by Hirose or Tanaka, and both Hirose and Tanaka fail to provide either the desirability or modification required by the Federal Circuit precedent outlined above.

Applicants, therefore, respectfully submit that the rejection of the claims under 35 U.S.C. § 103(a) based on Hirose, either alone or in combination with Tanaka, is unwarranted and should be withdrawn.

In view of the foregoing, reconsideration and withdrawal of the rejections under 35 U.S.C. Section 102(b) and Section 103 are respectfully requested.

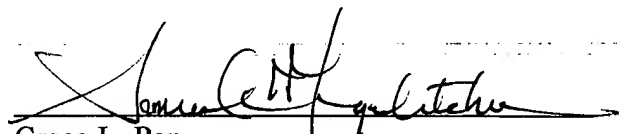
Pursuant to 37 C.F.R. §§1.136(a) and 1.17(a)(3), Applicants hereby request that the term for reply to the May 9, 2001 Office Action be extended three months, i.e., up to and including November 9, 2001. A check for \$920.00 is enclosed herewith.

Any additional fee occasioned by this paper and the petition for extension of time herein accompanying this paper, or any overpayment in those fees, may be charged or credited to Deposit Account No. 50-0320.

In view of the remarks herewith, the present application is in condition for allowance. Early and favorable reconsideration and prompt issuance of a Notice of Allowance are earnestly solicited. If any issue remains as an impediment to allowance, an interview is respectfully requested and the Examiner is further respectfully requested to contact the undersigned by telephone to arrange a mutually convenient time and manner for the interview.

Respectfully submitted,  
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